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Lawrence E. Page

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09/11/2006

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EXAMINER

STACE, BRENT S

ART UNIT

PAPER NUMBER

2161

DATE MAILED: 09/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/674,802

Applicant(s)

PAGE, LAWRENCE E.

Examiner

Brent S. Stace

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 June 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24, 26-28, 30-43 and 47-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24, 26-28, 30-43 and 47-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/21/06</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Remarks***

1. This communication is responsive to the amendment filed June 30<sup>th</sup>, 2006. Claims 1-24, 26-28, 30-43, and 47-49 are pending. In the amendment filed June 30<sup>th</sup>, 2006, Claims 1, 3, 9, 16-22, 26-28, 30, 37-43, and 47 are amended, Claims 25, 29, 44-46, and 50 are canceled, and Claims 1, 21, 22, 43, and 47 are independent. The examiner acknowledges that no new matter was introduced and the claims are supported by the specification. This action is FINAL.

### ***Response to Arguments***

2. Some of the Applicant's arguments filed June 30<sup>th</sup>, 2006 with respect to claims 1-24, 26-28, 30-43, and 47-49 have been considered but are not persuasive. Other arguments with respect to claims 1-24, 26-28, 30-43, and 47-49 have been considered but are moot in view of the new ground(s) of rejection (See below).

3. Independent Claims 1, 21, and 47 have substantially changed the scope of the claims. As such new art has been applied.

4. As to the applicant's arguments with respect to Claims 1, 21, and 47 for the prior art(s) allegedly not teaching "generating an integrated ranked listing comprising at least one characterization of at least one of the relevant web documents and at least one characterization of at least one of the relevant printed items," the examiner respectfully disagrees. New grounds of rejection are applied below from art originally sent to the

applicant from the first office action. The Kincaid reference has not been applied; therefore the applicant's proposed arguments with respect to Kincaid are moot.

5. As to the applicant's arguments with respect to Claims 22 for the prior art(s) allegedly not teaching "that each data set includes information representing an advertisement printed with the at least one of the printed items," the examiner respectfully disagrees. The Smith reference from the prior Office action has been applied to the amended claim. From the applicant's arguments it appears that the applicant is not considering the combination of the references in the rejection for Claim 22. Smith, has information representing an advertisement, as required by the claim. The printed items however do not come from Smith. Printed items and the data sets were mapped to Thomson (as can be seen from a prior rejection in the present claim). Smith merely adds advertisement data to the combination so that the integrity of the printed item with its advertisements in electronic form (if necessary) can be intact.

Also, specifically, the applicant argues that the prior art(s) allegedly do not teach "for the at least one of the relevant printed items, provide the information representing an advertisement for the at least one of the relevant printed items," the examiner respectfully disagrees. Smith, discloses in the cited section that ads are displayed to customers. The ads, when inserted into the database and displayed have provide information representing and advertisement. The displaying of the ad alone is providing information representing and advertisement. As for the relevant printed item(s) part of the limitation, again it appears that the applicant is not considering the combination of the references in the rejection for Claim 22. The printed items do not come from Smith.

Printed items and the data sets were mapped to Thomson (as can be seen from a prior rejection in the present claim). The art(s) meets the limitations of the claim as claimed.

6. As to the applicant's arguments with respect to Claim 4 for the prior art(s) allegedly not teaching "storing data sets representing the advertisements includes storing information for linking to information about a product represented in one of the advertisements," the examiner respectfully disagrees.

The "storing data sets representing the advertisements includes" part of the limitation has been met above with respect to the arguments regarding Claim 22.

As for the "storing information for linking to information about a product represented in one of the advertisements," the cited section of Smith teaches a database that stores URLs (linking information) to and about the advertisement being or to be displayed. This is linking information about a product represented in one of the advertisements being stored in a database.

Also the applicant argues that Smith appears to teach web-specific advertisements; not advertisements associated with printed items at all. This argument also has been met above with respect to the arguments regarding Claim 22.

7. As to the applicant's arguments with respect to Claim 8 for the prior art(s) allegedly not teaching "returning at least one characterization of at least one of the relevant printed items including returning information from a data set representing an advertisement for said at least one of the relevant printed items," the examiner respectfully disagrees.

First, the part of the limitation of “returning at least one characterization of at least one of the relevant printed items includes,” as reflected in the independent claim (since it was originally cited there), has not been mapped to Smith, but rather to Thomson, col. 8, lines 47-57. Therefore the argument that Smith does not teach this part of the limitation is moot since Smith was not used in rejecting this part of the limitation. It appears that the applicant has not considered the combination of the references.

Lastly, as for the part of the limitation of “returning information from a data set representing an advertisement for said at least one of the relevant printed items.” It is important to note that this claim is dependent off of Claim 4. Claim 4 established that ads are in printed items. In summary, when considering all of the combinations, Google1, page1 displays search results, Thomson, col. 8, lines 47-57 displays characterizations (like excerpts) of the printed items (and other part(s) map(s) to printed items themselves as discussed above), and Smith, cols. 2-3, lines 59-5 stores advertisements from the printed items in a database (as combined). The excerpt characterization matching the query and displayed in the search results (much like how Google1, page 1 does it) is the stored advertisement from the printed item.

8. As to the applicant’s arguments with respect to Claim 43, the examiner has already met these arguments individually above.

9. The examiner would like to note the incorrect status identifier for Claim 47. Claim 47’s status identifier alleges that it is original, however, the claim is amended.

Assuming the Applicant did not intend to receive a notice of non-compliant amendment, the examiner has assumed this was a typographical error. However, future

amendments should indicate the proper status identifier (e.g. previously presented, currently amended, etc.) for at least Claim 47.

10. The other claims argued merely because of a dependency on a previously argued claim(s) in the arguments presented to the examiner, filed June 30<sup>th</sup>, 2006, are moot in view of the examiner's interpretation of the claims and art and are still considered rejected based on their respective rejections from the first Office action (parts of recited again below).

### ***Response to Amendment***

### ***Information Disclosure Statement***

11. The information disclosure statement is being considered by the examiner.

### ***Specification***

12. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

***Drawings***

13. The examiner has entered the drawing amendments. In light of the applicant's respective arguments or respective amendments, all previous drawing objections to the drawings have been withdrawn.

***Claim Objections***

14. In light of the applicant's respective arguments or respective amendments, all previous claim objections to the claims have been withdrawn, however new objection(s) is/are warranted by the amendments.

15. Claim 47 is objected to because of the following informality:

- a. Claim 47 line 12 recites "returning as search results a ranked listed including." It appears that the Applicant intended to recite "returning as search results a ranked listing including."

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

16. In light of the applicant's respective arguments or respective amendments, all previous 35 USC § 112 claim rejections to the claims have been withdrawn, however, new 35 USC § 112 claim rejection(s) is/are warranted by the amended claims.

17. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.



18. Claim 41 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

19. Claim 41 recites the limitation "the ranked characterizations" in line 3. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claims 1, 13-17, 21, and 47, are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,634,051 (Thomson) in view of "How to Interpret your Search Results" (Google1), further in view of "The Anatomy of a Large-Scale Hypertextual Web Search Engine" (Brin et al.) (This reference was provided with the first Office action).

For **Claim 1**, Thomson teaches: "A computer-implemented method comprising:

- storing in a searchable database data sets representing printed items from publications respectively printed by a plurality of respective publishers, [Thomson, col. 10, lines 1-16 with Thomson, col. 8, lines 4-21] each data set including text from at least one of the printed items; [Thomson, col. 8, lines 4-21]

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- receiving a search query; [Thomson, col. 3, lines 47-50 with Thomson, col. 4, lines 9-13]
- searching the data sets in the electronic database for data sets representing printed items that are relevant to the search query; [Thomson, col. 8, lines 16-21 with Thomson, col. 10, lines 1-5] and
- and at least one characterization of at least one of the relevant printed items [Thomson, col. 8, lines 47-57].

Thomson discloses the above limitations but does not expressly teach:

- "storing an index representing information included in a plurality of web documents;
- searching the index for web documents that are relevant to the search query;
- generating an integrated ranked listing comprising at least one characterization of at least one of the relevant web documents
- and for said at least one of the relevant printed items, providing an electronic reference for accessing further information."

With respect to Claim 1, an analogous art, Google1, teaches:

- "storing an index representing information included in a plurality of web documents; [Google1, page 2, letter K]
- searching the index for web documents that are relevant to the search query: [Google1, page 1 with Google1, page 2, letter K]
- generating an integrated comprising at least one characterization of at least one of the relevant web documents [Google1, page 1]

- and for said at least one of the relevant printed items, providing an electronic reference for accessing further information” [Google1, page 1 with Thomson, col. 8, lines 4-10].”

With respect to Claim 1, an analogous art, Brin, teaches:

- “ranked listing” [Brin, page 13, Fig. 4].

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Google1 and Brin with Thomson because the inventions are directed towards searching documents.

Google1 and Brin’s inventions would have been expected to successfully work well with Thomson’s invention because the inventions use the internet for searching. Thomson discloses an information management systems comprising searching for documents relevant to a query, however Thomson does not expressly disclose web documents as search results and characterizations thereof, electronic reference for access, or a ranked result listing. Google1 discloses search results from Google comprising web pages as search results and characterizations thereof and an electronic reference for access. Brin discloses the same Google invention with results showing a ranked result listing.

It would have been obvious to one of ordinary skill in the art at the time of invention to take the web pages as search results, characterizations thereof, and electronic paths for access from Google1 and the ranked result listing from Brin and install them into the invention of Thomson, thereby offering the obvious advantage of finding web pages associated with the documents found, accessing them and the user

quickly determining the relevance of the returned result(s), and showing most relevant results first and including a view to the original document.

**Claim 13** can be mapped to Thomson (as modified by Google1 and Brin) as follows: "The method of claim 1, further including creating an index of the data sets in the searchable database" [Thomson, col. 8, lines 16-21].

**Claim 14** can be mapped to Thomson (as modified by Google1 and Brin) as follows: "The method of claim 1, further including configuring the data set to display as a replica of the corresponding printed media" [Thomson, col. 10, lines 1-16].

**Claim 15** can be mapped to Thomson (as modified by Google1 and Brin) as follows: "The method of claim 1, further including creating an index of the data sets in the searchable database and wherein returning includes providing a hyperlink for an indexed entry with another representation of one of the printed items" [Google1, page 1 with Google1, Page 2, Q].

**Claim 16** can be mapped to Thomson (as modified by Google1 and Brin) as follows: "The method of claim 1, wherein providing an electronic path for accessing further information includes providing at least one hyperlink that, when acted upon, links said at least one of the relevant printed items to a more complete electronic representation of the relevant printed items" [Google1, page 1 with Google1, Page 2, K, L, and O].

**Claim 17** can be mapped to Thomson (as modified by Google1 and Brin) as follows: "The method of claim 1, wherein providing an electronic path for accessing further information includes providing at least one hyperlink that, when acted upon, links

said at least one of the relevant printed items to an electronic representation of the relevant printed item, the electronic representation of the relevant printed item beginning as a continuation of information returned” [Google1, page 1 with Google1, Page 2, K, L, and O].

For **Claim 21**, Thomson teaches: “A computer-implemented arrangement including a search engine [Thomson, col. 4, lines 36-41] and a searchable electronic database, [Thomson, col. 5, lines 15-20] the computer-implemented arrangement adapted to respond to Internet-based search queries, [Thomson, col. 3, lines 47-50 with Thomson, col. 4, lines 9-13] comprising:

- means for storing in the searchable database data sets representing printed items from publications respectively printed by a plurality of respective publishers, [Thomson, col. 10, lines 1-16 with Thomson, col. 8, lines 4-21] each data set including text from at least one of the printed items; [Thomson, col. 8, lines 4-21] and
- means, including the search engine, for responding to a search query and including
- and searching the data sets in the electronic database for data sets that are relevant to the search query, thereby identifying relevant Internet web pages and relevant data sets corresponding to relevant publication items, [Thomson, col. 8, lines 16-21]
- and at least one characterization of at least one of the relevant publication items [Thomson, col. 8, lines 47-57] and

- means for the returned and at least one characterization of at least one of the relevant publication items [Thomson, col. 8, lines 47-57] to generate an integrated of relevant characterizations."

Thomson discloses the above limitations but does not expressly teach:

- "means for searching for web pages that are relevant for the search query
- means for returning at least one characterization of at least one of the relevant web pages
- and, for said at least one of the relevant publication items, providing an electronic path for accessing further information;
- ranking
- at least one characterization of at least one of the relevant web pages
- ranked listing."

With respect to Claim 21, an analogous art, Google1, teaches:

- "means for searching for web pages that are relevant for the search query [Google1, page 1]
- means for returning at least one characterization of at least one of the relevant web pages [Google1, page 1]
- and, for said at least one of the relevant publication items, providing an electronic path for accessing further information; [Google1, page 1 with Thomson, col. 8, lines 4-10]

With respect to Claim 21, an analogous art, Brin, teaches:

- "ranking [Brin, page 13, Fig. 4]

- ranked listing" [Brin, page 13, Fig. 4].

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Google1 and Brin with Thomson because the inventions are directed towards searching documents.

Google1 and Brin's inventions would have been expected to successfully work well with Thomson's invention because the inventions use the internet for searching. Thomson discloses an information management systems comprising searching for documents relevant to a query, however Thomson does not expressly disclose web documents as search results and characterizations thereof, electronic reference for access, or a ranked result listing. Google1 discloses search results from Google comprising web pages as search results and characterizations thereof and an electronic reference for access. Brin discloses the same Google invention with results showing a ranked result listing.

It would have been obvious to one of ordinary skill in the art at the time of invention to take the web pages as search results, characterizations thereof, and electronic paths for access from Google1 and the ranked result listing from Brin and install them into the invention of Thomson, thereby offering the obvious advantage of finding web pages associated with the documents found, accessing them and the user quickly determining the relevance of the returned result(s), and showing most relevant results first and including a view to the original document.

For **Claim 47**, Thomson teaches: "A machine-implemented method for searching one or more searchable electronic databases, [Thomson, col. 4, lines 9-20 with Thomson, col. 5, lines 15-20] comprising:

- storing data sets representing publication items respectively produced by a plurality of respective publishers; [Thomson, col. 10, lines 1-16 with Thomson, col. 8, lines 4-21]
- responsive to a search query, and searching the data sets in the electronic database for the data sets that are relevant to the search query, thereby identifying web-accessible documents and relevant data sets corresponding to relevant publication items; [Thomson, col. 8, lines 16-21]
- the identified web-accessible documents and the relevant data sets corresponding to relevant publication items; [Thomson, col. 8, lines 16-21] and
- returning as search results including
- at least one characterization of at least one of the relevant publication items" [Thomson, col. 8, lines 47-57].

Thomson discloses the above limitations but does not expressly teach:

- "electronically searching for web-accessible documents that are relevant to the search query
- ranking
- a ranked listed
- at least one characterization of at least one of the relevant web-accessible documents, and



- for said at least one of the relevant publication items, an electronic path for accessing further information.”

With respect to Claim 47, an analogous art, Google1, teaches:

- “electronically searching for web-accessible documents that are relevant to the search query [Google1, page 1]
- at least one characterization of at least one of the relevant web-accessible documents, [Google1, page 1] and
- for said at least one of the relevant publication items, an electronic path for accessing further information” [Google1, page 1 with Thomson, col. 8, lines 4-10].

With respect to Claim 47, an analogous art, Brin, teaches:

- “ranking [Brin, page 13, Fig. 4]
- a ranked listed” [Brin, page 13, Fig. 4].

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Google1 and Brin with Thomson because the inventions are directed towards searching documents.

Google1 and Brin’s inventions would have been expected to successfully work well with Thomson’s invention because the inventions use the internet for searching. Thomson discloses an information management systems comprising searching for documents relevant to a query, however Thomson does not expressly disclose web documents as search results and characterizations thereof, electronic reference for access, or a ranked result listing. Google1 discloses search results from Google

comprising web pages as search results and characterizations thereof and an electronic reference for access. Brin discloses the same Google invention with results showing a ranked result listing.

It would have been obvious to one of ordinary skill in the art at the time of invention to take the web pages as search results, characterizations thereof, and electronic paths for access from Google1 and the ranked result listing from Brin and install them into the invention of Thomson, thereby offering the obvious advantage of finding web pages associated with the documents found, accessing them and the user quickly determining the relevance of the returned result(s), and showing most relevant results first and including a view to the original document.

22. Claims 2, 3, 48, and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,634,051 (Thomson) in view of "How to Interpret your Search Results" (Google1), in view of "The Anatomy of a Large-Scale Hyptertextual Web Search Engine" (Brin et al.), further in view of U.S. Patent Application Publication No. 2003/0229637 (Baxter et al.).

For **Claim 2**, Thomson (as modified by Google1 and Brin) teaches: "The method of claim 1."

Thomson (as modified by Google1 and Brin) discloses the above limitation but does not expressly teach: "wherein the printed items, that are represented by stored data sets in the searchable database, are copyrighted printed items."

With respect to Claim 2, an analogous art, Baxter, teaches: "wherein the printed items, that are represented by stored data sets in the searchable database, are copyrighted printed items" [Baxter, paragraph [0138]].

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Baxter with Thomson (as modified by Google1 and Brin) because both inventions are directed towards searching for documents.

Baxter's invention would have been expected to successfully work well with Thomson (as modified by Google1 and Brin)'s invention because both inventions use databases. Thomson (as modified by Google1 and Brin) discloses an information management systems comprising searching for documents relevant to a query, however Thomson (as modified by Google1 and Brin) does not expressly disclose that these documents are copyrighted or that a permission protocol is used for the publisher to permit the search engine to display more text from the publication items. Baxter discloses a method an apparatus for safeguarding files comprising copyrighted documents/publications and a permission protocol.

It would have been obvious to one of ordinary skill in the art at the time of invention to take the copyrighted material from Baxter and install it into the invention of Thomson (as modified by Google1 and Brin), thereby offering the obvious advantage of including more searchable material in the index of Thomson (as modified by Google1 and Brin) to possibly retrieve more relevant results to a query.

**Claim 3** can be mapped to Thomson (as modified by Google1, Brin, and Baxter) as follows: "The method of claim 2, further including executing a permission protocol in

which the publisher provides authorization that permits the search engine to display more text from said at least one of the relevant printed items” [Baxter, paragraphs [0037], [0041], [0141] and [0145] with Thomson, col. 8, lines 4-10 with Thomson, col. 8, lines 47-57 with Thomson, col. 3, lines 50-65].

For **Claim 48**, Thomson (as modified by Google1 and Brin) teaches: “The machine-implemented method of claim 47.”

Thomson (as modified by Google1 and Brin) discloses the above limitation but does not expressly teach:

- “wherein the electronic path includes a path for accessing data made available according to a permission protocol.”

With respect to Claim 48, an analogous art, Baxter, teaches:

- “wherein the electronic path includes a path for accessing data made available according to a permission protocol” [Baxter, paragraphs [0037], [0041], [0141] and [0145] with Thomson, col. 8, lines 4-10 with Thomson, col. 8, lines 47-57 with Thomson, col. 3, lines 50-65].

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Baxter with Thomson (as modified by Google1 and Brin) because both inventions are directed towards searching for documents.

Baxter’s invention would have been expected to successfully work well with Thomson (as modified by Google1 and Brin)’s invention because both inventions use databases. Thomson (as modified by Google1 and Brin) discloses an information management systems comprising searching for documents relevant to a query,

however Thomson (as modified by Google1 and Brin) does not expressly disclose that the path is made available according to a permissions protocol. Baxter discloses a method an apparatus for safeguarding files comprising a permission protocol.

It would have been obvious to one of ordinary skill in the art at the time of invention to take the permission protocol from Baxter and install it into the invention of Thomson (as modified by Google1 and Brin), thereby offering the obvious advantage of safeguarding files from non-authorized users so that non-authorized users are not given a path to access the document.

For **Claim 49**, Thomson (as modified by Google1 and Brin) teaches: "The machine-implemented method of claim 47."

Thomson (as modified by Google1 and Brin) discloses the above limitation but does not expressly teach:

- "wherein the electronic path provides access to further information made available by a publisher of the further information" [Baxter, paragraphs [0037], [0041], [0141] and [0145] with Thomson, col. 8, lines 4-10 with Thomson, col. 8, lines 47-57 with Thomson, col. 3, lines 50-65].

With respect to Claim 49, an analogous art, Baxter, teaches:

- "wherein the electronic path provides access to further information made available by a publisher of the further information" [Baxter, paragraphs [0037], [0041], [0141] and [0145] with Thomson, col. 8, lines 4-10 with Thomson, col. 8, lines 47-57 with Thomson, col. 3, lines 50-65].

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Baxter with Thomson (as modified by Google1 and Brin) because both inventions are directed towards searching for documents.

Baxter's invention would have been expected to successfully work well with Thomson (as modified by Google1 and Brin)'s invention because both inventions use databases. Thomson (as modified by Google1 and Brin) discloses an information management systems comprising searching for documents relevant to a query, however Thomson (as modified by Google1 and Brin) does not expressly disclose that the path provides access to further information made available by a publisher of the further information. Baxter discloses a method an apparatus for safeguarding files comprising copyrighted documents/publications and a permission protocol.

It would have been obvious to one of ordinary skill in the art at the time of invention to take the permission protocol from Baxter and install it into the invention of Thomson (as modified by Google1 and Brin), thereby offering the obvious advantage of safeguarding files from non-authorized users so that authorized users are given a path to access further information.

23. Claims 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,634,051 (Thomson) in view of "How to Interpret your Search Results" (Google1) in view of "The Anatomy of a Large-Scale Hyptertextual Web Search Engine" (Brin et al.), further in view of U.S. Patent No. 6,502,076 (Smith).

For **Claim 4**, Thomson (as modified by Google1 and Brin) teaches: "The method of claim 1, wherein storing data sets representing printed items includes."

Thomson (as modified by Google1 and Brin) discloses the above limitation but does not expressly teach: "storing data sets representing advertisements printed with the printed items."

With respect to Claim 4, an analogous art, Smith, teaches: "storing data sets representing advertisements printed with the printed items" [Smith, cols. 2-3, lines 59-5].

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Smith with Thomson (as modified by Google1 and Brin) because both inventions are directed towards displaying documents on the web.

Smith's invention would have been expected to successfully work well with Thomson (as modified by Google1 and Brin)'s invention because both inventions use computers to display documents. Thomson (as modified by Google1 and Brin) discloses a an information management systems comprising searching for documents relevant to a query, however Thomson (as modified by Google1 and Brin) does not expressly disclose that advertisements from the printed items are also stored in data sets. Smith discloses a system and methods for determining and displaying product promotions comprising a database of ads with their associated information.

It would have been obvious to one of ordinary skill in the art at the time of invention to take the database of ads with their associated information from Smith and install it into the invention of Thomson (as modified by Google1 and Brin), thereby offering the obvious advantage of storing/maintaining the ads independently which

allows for advertisements to be modified independently, and the reuse/repeating of the same advertisement multiple times.

Thomson, Google1, Brin, and Smith all fail to teach that advertisements are in printed items. Official notice is taken that it is old and well known in the document art that to get the advantage of complete document integrity it is necessary to include advertisements in the storing of printed items that contain advertisements. It would have been obvious to one of ordinary skill in the art at the time of invention to include advertisements to get this advantage.

**Claim 5** can be mapped to Thomson (as modified by Google1, Brin, and Smith) as follows: "The method of claim 4, wherein storing data sets representing the advertisements includes storing information for linking to information about a product represented in one of the advertisements" [Smith, cols. 2-3, lines 59-5].

**Claim 6** can be mapped to Thomson (as modified by Google1, Brin, and Smith) as follows: "The method of claim 4, wherein storing data sets representing the advertisements includes storing information for displaying information about a product represented in one of the advertisements" [Smith, cols. 2-3, lines 59-5].

**Claim 7** can be mapped to Thomson (as modified by Google1, Brin, and Smith) as follows: "The method of claim 4, wherein storing data sets representing the advertisements includes storing information directing the search engine to update advertisement information for one of the relevant printed items" [Smith, cols. 11-12, lines 61-14].



**Claim 8** can be mapped to Thomson (as modified by Google1, Brin, and Smith) as follows: "The method of claim 4, wherein storing data sets representing printed items includes storing data sets representing advertisements printed with the printed items; [Smith, cols. 2-3, lines 59-5] and wherein returning at least one characterization of at least one of the relevant printed items includes returning information from a data set representing an advertisement for said at least one of the relevant printed items" [Smith, cols. 2-3, lines 59-5 with Google1, page 1].

**Claim 9** can be mapped to Thomson (as modified by Google1, Brin, and Smith) as follows: "The method of claim 8, wherein returning information from a data set representing an advertisement includes returning information representing at least one of: information for linking to information about a product represented in one of the advertisements, information for displaying information about a product represented in one of the advertisements, or information directing the search engine to update advertisement information for one of the relevant printed items" [Smith, cols. 2-3, lines 59-5].

24. Claims 10 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,634,051 (Thomson) in view of "How to Interpret your Search Results" (Google1) in view of "The Anatomy of a Large-Scale Hypertextual Web Search Engine" (Brin et al.), further in view of U.S. Patent No. 5,963,966 (Mitchell et al.).

For **Claim 10**, Thomson (as modified by Google1 and Brin) teaches: "The method of claim 1."

Thomson (as modified by Google1 and Brin) discloses the above limitation but does not expressly teach:

- “further including electronically scanning the printed items and generating scanned printed items, and wherein the stored data sets representing printed items in the searchable database includes data sets representing the scanned printed items.”

With respect to Claim 10, an analogous art, Mitchell, teaches:

- “further including electronically scanning the printed items and generating scanned printed items, and wherein the stored data sets representing printed items in the searchable database includes data sets representing the scanned printed items” [Mitchell, col. 6, lines 33-44 with Thomson, col. 10, lines 1-5].

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Mitchell with Thomson (as modified by Google1 and Brin) because both inventions are directed towards converting documents to electronic form.

Mitchell's invention would have been expected to successfully work well with Thomson (as modified by Google1 and Brin)'s invention because both inventions convert documents to an electronic format. Thomson (as modified by Google1 and Brin) discloses an information management systems comprising searching for documents relevant to a query, however Thomson (as modified by Google1 and Brin) does not expressly disclose that the documents for searching are converted to electronic form by scanning. Mitchell discloses automated capture of technical

documents for electronic review and distribution comprising scanning and OCRing of documents.

It would have been obvious to one of ordinary skill in the art at the time of invention to take the scanning and OCRing of documents from Mitchell and install it into the electron conversion system of Thomson (as modified by Google1 and Brin), thereby offering the obvious advantage of having a automated way of inputting documents into the database.

For **Claim 20**, Thomson (as modified by Google1 and Brin) teaches: "The method of claim 1 wherein the integrated ranked listing includes."

Thomson (as modified by Google1 and Brin) discloses the above limitation but does not expressly teach: "hyperlinks to respective electronic images of the relevant printed items and relevant web documents."

With respect to Claim 20, an analogous art, Mitchell, teaches: "hyperlinks to respective electronic images of the relevant printed items and relevant web documents" [Mitchell, col. 7, lines 42-50 with Google1, page 1].

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Mitchell with Thomson (as modified by Google1 and Brin) because the inventions are directed towards accessing documents.

Mitchell's invention would have been expected to successfully work well with Thomson (as modified by Google1 and Brin)'s invention because the inventions use databases. Thomson (as modified by Google1 and Brin) discloses an information management systems comprising searching for documents relevant to a query,

however Thomson (as modified by Google1 and Brin) does not expressly disclose providing a link to the image of the document. Mitchell discloses automated capture of technical documents for electronic review and distribution comprising accessing the images of the scanned documents.

It would have been obvious to one of ordinary skill in the art at the time of invention to take the images of the scanned documents from Mitchell and install it into the invention of Thomson (as modified by Google1 and Brin), thereby offering the obvious advantage of including a view to the original document and web material.

25. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,634,051 (Thomson) in view of "How to Interpret your Search Results" (Google1) in view of "The Anatomy of a Large-Scale Hypertextual Web Search Engine" (Brin et al.), in view of U.S. Patent No. 5,963,966 (Mitchell et al.), further in view of U.S. Patent Application Publication No. 2003/0229637 (Baxter et al.).

For **Claim 11**, Thomson (as modified by Google1, Brin, and Mitchell) teaches:  
"The method of claim 10."

Thomson (as modified by Google1, Brin, and Mitchell) discloses the above limitation but does not expressly teach:

- "wherein the scanned printed items are copyrighted printed items, and further including executing a permission protocol in which the publisher provides authorization over the Internet that permits the search engine to display more text from said at least one of the relevant publication items, the authorization being in

response to the search engine providing the electronic path for accessing further information for said at least one of the relevant publication items.”

With respect to Claim 11, an analogous art, Baxter, teaches:

- “wherein the scanned printed items are copyrighted printed items, [Baxter, paragraph [0138]] and further including executing a permission protocol in which the publisher provides authorization over the Internet that permits the search engine to display more text from said at least one of the relevant publication items, [Baxter, paragraphs [0037], [0041], [0141] and [0145] with Thomson, col. 8, lines 4-10 with Thomson, col. 8, lines 47-57 with Thomson, col. 3, lines 50-65] the authorization being in response to the search engine providing the electronic path for accessing further information for said at least one of the relevant publication items [Baxter, paragraph [0144]].

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Baxter with Thomson (as modified by Google1, Brin, and Mitchell) because both inventions are directed towards searching for documents.

Baxter's invention would have been expected to successfully work well with Thomson (as modified by Google1, Brin, and Mitchell)'s invention because both inventions use databases. Thomson (as modified by Google1, Brin, and Mitchell) discloses an information management systems comprising searching for documents relevant to a query, however Thomson (as modified by Google1, Brin, and Mitchell) does not expressly disclose that these documents are copyrighted or that a permission protocol is used for the publisher to permit the search engine to display more text from

the publication items. Baxter discloses a method and apparatus for safeguarding files comprising copyrighted documents/publications and a permission protocol.

It would have been obvious to one of ordinary skill in the art at the time of invention to take the copyrighted material from Baxter and install it into the invention of Thomson (as modified by Google1, Brin, and Mitchell), thereby offering the obvious advantage of including more searchable material in the index of Thomson (as modified by Google1, Brin, and Mitchell) to possibly retrieve more relevant results to a query.

For **Claim 12**, Thomson (as modified by Google1, Brin, and Mitchell) teaches:  
“The method of claim 10.”

Thomson (as modified by Google1, Brin, and Mitchell) discloses the above limitation but does not expressly teach:

- “wherein the scanned printed items are copyrighted printed items, and further including executing a permission protocol in which the publisher provides authorization over the Internet that permits the search engine to display more text from said at least one of the relevant publication items, the authorization being in response to a representative of the publisher submitting the search query and, in response the search engine providing the electronic path for accessing further information for said at least one of the relevant publication items.”

With respect to Claim 12, an analogous art, Baxter, teaches:

- “wherein the scanned printed items are copyrighted printed items, [Baxter, paragraph [0138]] and further including executing a permission protocol in which the publisher provides authorization over the Internet that permits the search

engine to display more text from said at least one of the relevant publication items, [Baxter, paragraphs [0037], [0041], [0141] and [0145] with Thomson, col. 8, lines 4-10 with Thomson, col. 8, lines 47-57 with Thomson, col. 3, lines 50-65] the authorization being in response to a representative of the publisher submitting the search query and, in response the search engine providing the electronic path for accessing further information for said at least one of the relevant publication items" [Baxter, paragraphs [0080], [0143] and [0144]].

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Baxter with Thomson (as modified by Google1, Brin, and Mitchell) because both inventions are directed towards searching for documents.

Baxter's invention would have been expected to successfully work well with Thomson (as modified by Google1, Brin, and Mitchell)'s invention because both inventions use databases. Thomson (as modified by Google1, Brin, and Mitchell) discloses an information management systems comprising searching for documents relevant to a query, however Thomson (as modified by Google1, Brin, and Mitchell) does not expressly disclose that these documents are copyrighted or that a permission protocol is used for the publisher to permit the search engine to display more text from the publication items. Baxter discloses a method an apparatus for safeguarding files comprising copyrighted documents/publications and a permission protocol.

It would have been obvious to one of ordinary skill in the art at the time of invention to take the copyrighted material from Baxter and install it into the invention of Thomson (as modified by Google1, Brin, and Mitchell), thereby offering the obvious

advantage of including more searchable material in the index of Thomson (as modified by Google1, Brin, and Mitchell) to possibly retrieve more relevant results to a query.

26. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,634,051 (Thomson) in view of "How to Interpret your Search Results" (Google1) in view of "The Anatomy of a Large-Scale Hypertextual Web Search Engine" (Brin et al.), further in view of U.S. Patent No. 5,832,212 (Cragun et al.).

For **Claim 18**, Thomson (as modified by Google1 and Brin) teaches: "The method of claim 1."

Thomson (as modified by Google1 and Brin) discloses the above limitation but does not expressly teach: "further including blocking portions of the relevant printed items that are not authorized for distribution."

With respect to Claim 18, an analogous art, Cragun, teaches: "further including blocking portions of the relevant printed items that are not authorized for distribution" [Cragun, cols, 6-7, lines 54-17].

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Cragun with Thomson (as modified by Google1 and Brin) because both inventions are directed towards displaying content on the internet.

Cragun's invention would have been expected to successfully work well with Thomson (as modified by Google1 and Brin)'s invention because both inventions use web browsers. Thomson (as modified by Google1 and Brin) discloses an information management systems comprising searching for documents relevant to a query,



however Thomson (as modified by Google1 and Brin) does not expressly disclose blocking out content not authorized to be viewed. Cragun discloses censoring browser method and apparatus for internet viewing comprising blocking out unauthorized content.

It would have been obvious to one of ordinary skill in the art at the time of invention to take the blocking out unauthorized content from Cragun and install it into the invention of Thomson (as modified by Google1 and Brin), thereby offering the obvious advantage of gaining document security for portions of documents not to be viewed.

27. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,634,051 (Thomson) in view of "How to Interpret your Search Results" (Google1) in view of "The Anatomy of a Large-Scale Hyptertextual Web Search Engine" (Brin et al.), further in view of "Google Search Technology" (Google2).

For **Claim 19**, Thomson (as modified by Google1 and Brin) teaches: "The method of claim 1."

Thomson (as modified by Google1 and Brin) discloses the above limitation but does not expressly teach: "wherein returning includes embedding advertisements with said at least one characterization of at least one of the relevant printed items."

With respect to Claim 19, an analogous art, Google2, teaches: "wherein returning includes embedding advertisements with said at least one characterization of at least one of the relevant printed items" [Google2, Page 1, under Integrity].

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Google2 with Thomson (as modified by Google1 and Brin) because both inventions are directed towards searching for documents.

Google2's invention would have been expected to successfully work well with Thomson (as modified by Google1 and Brin)'s invention because both inventions return search results. Thomson (as modified by Google1 and Brin) discloses an information management systems comprising searching for documents relevant to a query, however Thomson (as modified by Google1 and Brin) does not expressly disclose embedding advertisements with characterization(s). Google2 discloses search results comprising advertisements/ads.

It would have been obvious to one of ordinary skill in the art at the time of invention to take the ads from Google2 and install it into the invention of Thomson (as modified by Google1 and Brin), thereby offering the obvious advantage of including more relevant results in the form of ads.

28. Claims 22, 26-28, 30, and 34-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,634,051 (Thomson) in view of "How to Interpret your Search Results" (Google1), further in view of U.S. Patent No. 6,502,076 (Smith).

For **Claim 22**, Thomson teaches: "A computer-implemented arrangement including a search engine [Thomson, col. 4, lines 36-41] and a searchable electronic database, [Thomson, col. 5, lines 15-20] the computer-implemented arrangement adapted to

respond to Internet-based search queries, [Thomson, col. 3, lines 47-50 with Thomson, col. 4, lines 9-13] comprising:

- “a memory bank and a first programmable computer node, [Thomson, col. 3, lines 30-42] the memory bank and the programmable computer node being adapted to store the searchable database as data sets representing printed items from publications respectively printed by a plurality of respective publishers, [Thomson, col. 10, lines 1-16 with Thomson, col. 8, lines 4-21] each data set including text from at least one of the printed items [Thomson, col. 8, lines 4-21] and
- and to search the data sets in the electronic database for data sets that are relevant to the search query, thereby identifying relevant Internet web pages and relevant data sets corresponding to relevant printed items, [Thomson, col. 8, lines 16-21] and
- and at least one characterization of at least of the relevant printed items” [Thomson, col. 8, lines 47-57].

Thomson discloses the above limitations but does not expressly teach:

- “and information representing an advertisement printed with the at least one of the printed items;
- a second programmable computer node including the search engine, the second programmable computer node adapted to search for web pages that are relevant for a search query
- to return at least one characterization of at least one of the relevant web pages

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- and, for said at least one of the relevant printed items, to provide the information representing an advertisement for said at least one of the relevant printed items.”

With respect to Claim 22, an analogous art, Google1, teaches:

- “a second programmable computer node including the search engine, [Google, page 1 with Thomson, col. 4, lines 25-30 with Thomson, col. 4, lines 36-41] the second programmable computer node adapted to search for web pages that are relevant for a search query [Google1, page 1]
- to return at least one characterization of at least one of the relevant web pages [Google1, page 1]

With respect to Claim 22, an analogous art, Smith, teaches:

- “and information representing an advertisement printed with the at least one of the printed items; [Smith, cols. 2-3, lines 59-5]
- and, for said at least one of the relevant printed items, to provide the information representing an advertisement for said at least one of the relevant printed items” [Smith, cols. 2-3, lines 59-5 with Google1, page 1].

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Google1 and Smith with Thomson because the inventions are directed towards displaying documents on the web.

Google1 and Smith's inventions would have been expected to successfully work well with Thomson's invention because the inventions use the internet for searching. Thomson discloses an information management systems comprising searching for documents relevant to a query, however Thomson does not expressly disclose web

documents as search results and characterizations thereof, electronic reference for access, or that advertisements from the printed items are also stored in data sets.

Google1 discloses search results from Google comprising web pages as search results and characterizations thereof and an electronic reference for access. Smith discloses system and methods for determining and displaying product promotions comprising a database of ads with their associated information.

It would have been obvious to one of ordinary skill in the art at the time of invention to take the web pages as search results, characterizations thereof, and electronic paths for access from Google1 and the database of ads with their associated information from Smith and install them into the invention of Thomson, thereby offering the obvious advantage of finding web pages associated with the documents found, accessing them and the user quickly determining the relevance of the returned result(s), and storing/maintaining the ads independently which allows for advertisements to be modified independently, and the reuse/repeating of the same advertisement multiple times.

Thomson, Google1, and Smith all fail to teach that advertisements are in printed items. Official notice is taken that it is old and well known in the document art that to get the advantage of complete document integrity it is necessary to include advertisements in the storing of printed items that contain advertisements. It would have been obvious to one of ordinary skill in the art at the time of invention to include advertisements to get this advantage.

**Claims 26-28 and 30's** limitation(s) have already been met by Claims 5-7 and 9's limitation(s), respectfully. Therefore, Claims 26-28 and 30 are rejected for the same reason(s) as stated above with respect to Claims 5-7 and 9, respectfully (except as appropriate, the rejections would be Thomson (as modified by Google1 and Smith) as justified by the rejection on Claim 22).

**Claims 34-38's** limitation(s) have already been met by Claims 13-17's limitation(s), respectfully. Therefore, Claims 34-38 are rejected for the same reason(s) as stated above with respect to Claims 13-17, respectfully (except as appropriate, the rejections would be Thomson (as modified by Google1 and Smith) as justified by the rejection on Claim 22).

29. Claims 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,634,051 (Thomson) in view of "How to Interpret your Search Results" (Google1) in view of U.S. Patent No. 6,502,076 (Smith), further in view of U.S. Patent Application Publication No. 2003/0229637 (Baxter et al.).

**Claims 23 and 24's** limitation(s) have already been met by Claims 2 and 3's limitation(s), respectfully. Therefore, Claims 23 and 24 are rejected for the same reason(s) as stated above with respect to Claims 2 and 3, respectfully (except as appropriate, the rejections would be Thomson (as modified by Google1, and Smith) as justified by the rejection on Claim 22).

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30. Claims 31 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,634,051 (Thomson) in view of "How to Interpret your Search Results" (Google1) in view of U.S. Patent No. 6,502,076 (Smith), further in view of U.S. Patent No. 5,963,966 (Mitchell et al.).

**Claim 31's** limitation(s) have already been met by Claim 10's limitation(s).

Therefore, Claim 31 is rejected for the same reason(s) as stated above with respect to Claim 10 (except as appropriate, the rejections would be Thomson (as modified by Google1, and Smith) as justified by the rejection on Claim 22).

For **Claim 42**, Thomson (as modified by Google1) teaches: "The arrangement of claim 22, further including."

Thomson (as modified by Google1) discloses the above limitation but does not expressly teach:

- "an item-input arrangement including both a document scanner and a download path arranged to download an electronic version of at least one of the printed items, the item-input arrangement adapted to generate electronic versions of the printed items."

With respect to Claim 42, an analogous art, Mitchell, teaches:

- "an item-input arrangement including both a document scanner and a download path arranged to download an electronic version of at least one of the printed items, the item-input arrangement adapted to generate electronic versions of the printed items" [Mitchell, col. 7, lines 6-14]."

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Mitchell with Thomson (as modified by Google1) because both inventions are directed towards converting documents to electronic form.

Mitchell's invention would have been expected to successfully work well with Thomson (as modified by Google1)'s invention because both inventions convert documents to an electronic format. Thomson (as modified by Google1) discloses a an information management systems comprising searching for documents relevant to a query, however Thomson (as modified by Google1) does not expressly disclose that the documents for searching are converted to electronic form by scanning. Mitchell discloses automated capture of technical documents for electronic review and distribution comprising scanning and OCRing of documents.

It would have been obvious to one of ordinary skill in the art at the time of invention to take the scanner and download path (OCR) from Mitchell and install it into the invention of Thomson (as modified by Google1), thereby offering the obvious advantage of having an automated process to convert documents speeding up conversion.

31. Claims 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,634,051 (Thomson) in view of "How to Interpret your Search Results" (Google1) in view of U.S. Patent No. 6,502,076 (Smith) in view of U.S. Patent No. 5,963,966 (Mitchell et al.), further in view of U.S. Patent Application Publication No. 2003/0229637 (Baxter et al.).



**Claims 32 and 33's** limitation(s) have already been met by Claims 11 and 12's limitation(s), respectfully. Therefore, Claims 32 and 33 are rejected for the same reason(s) as stated above with respect to Claims 11 and 12, respectfully (except as appropriate, the rejections would be Thomson (as modified by Google1, and Smith) as justified by the rejection on Claim 22).

32. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,634,051 (Thomson) in view of "How to Interpret your Search Results" (Google1) in view of U.S. Patent No. 6,502,076 (Smith), further in view of U.S. Patent No. 5,832,212 (Cragun et al.).

**Claim 39's** limitation(s) have already been met by Claim 18's limitation(s). Therefore, Claim 39 is rejected for the same reason(s) as stated above with respect to Claim 18 (except as appropriate, the rejections would be Thomson (as modified by Google1, and Smith) as justified by the rejection on Claim 22).

33. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,634,051 (Thomson) in view of "How to Interpret your Search Results" (Google1) in view of U.S. Patent No. 6,502,076 (Smith), further in view of "Google Search Technology" (Google2).

**Claim 40's** limitation(s) have already been met by Claim 19's limitation(s). Therefore, Claim 40 is rejected for the same reason(s) as stated above with respect to

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Claim 19 (except as appropriate, the rejections would be Thomson (as modified by Google1, and Smith) as justified by the rejection on Claim 22).

34. Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,634,051 (Thomson) in view of "How to Interpret your Search Results" (Google1) in view of U.S. Patent No. 6,502,076 (Smith), in view of "The Anatomy of a Large-Scale Hyptertextual Web Search Engine" (Brin et al.), further in view of U.S. Patent No. 5,963,966 (Mitchell et al.).

For **Claim 41**, Thomson (as modified by Google1 and Smith) teaches: "The arrangement of claim 22 wherein ranked characterizations include."

Thomson (as modified by Google1 and Smith) discloses the above limitation but does not expressly teach: "ranked characterizations include hyperlinks to respective electronic images of the relevant printed items and hyperlinks to respective web pages."

With respect to Claim 41, an analogous art, Brin, teaches: "ranked characterizations include" [Brin, page 13, Fig. 4].

With respect to Claim 41, an analogous art, Mitchell, teaches: "hyperlinks to respective electronic images of the relevant printed items and hyperlinks to respective web pages" [Mitchell, col. 7, lines 42-50 with Google1, page 1].

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Brin and Mitchell with Thomson (as modified by Google1 and Smith) because the inventions are directed towards accessing documents.

Brin and Mitchell's inventions would have been expected to successfully work well with Thomson (as modified by Google1 and Smith)'s invention because the inventions use databases. Thomson (as modified by Google1 and Smith) discloses an information management systems comprising searching for documents relevant to a query, however Thomson (as modified by Google1 and Smith) does not expressly disclose ranking results or providing a link to the image of the document. Mitchell discloses automated capture of technical documents for electronic review and distribution comprising accessing the images of the scanned documents. Brin discloses the same Google invention with results showing a ranked result listing.

It would have been obvious to one of ordinary skill in the art at the time of invention to take the ranking from Brin and the images of the scanned documents from Mitchell and install them into the invention of Thomson (as modified by Google1 and Smith), thereby offering the obvious advantage of showing most relevant results first and including a view to the original document and web material.

35. Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,634,051 (Thomson) in view of U.S. Patent Application Publication No. 2003/0229637 (Baxter et al.), in view of "How to Interpret your Search Results" (Google1), further in view of U.S. Patent No. 6,502,076 (Smith).

For **Claim 43**, Thomson teaches: "An arrangement for maintaining an electronic database [Thomson, col. 5, lines 15-20] that is searchable via a search engine

[Thomson, col. 4, lines 36-41] in response to Internet-based search queries, [Thomson, col. 3, lines 47-50 with Thomson, col. 4, lines 9-13] the arrangement comprising:

- means for storing in the searchable database data sets representing printed items from publications respectively printed by a plurality of respective publishers, [Thomson, col. 10, lines 1-16 with Thomson, col. 8, lines 4-21] each data set including text from at least one of the printed items [Thomson, col. 8, lines 4-21]
- and searching the data sets in the electronic database for data sets that are relevant to the search query, thereby identifying Internet web pages and relevant data sets corresponding to relevant publication items; [Thomson, col. 8, lines 16-21]
- and at least one characterization of at least one of the relevant publication items and” [Thomson, col. 8, lines 47-57].

Thomson discloses the above limitations but does not expressly teach:

- “with each stored data set representing printed items from publications, means for recording whether the respective publisher has authorized display of the printed item
- wherein the data sets representing printed items include advertisements related to the printed items, the advertisements including information for linking to information about a corresponding product;
- means, responsive to a search query and including the search engine, for searching for web pages that are relevant for the search query

- means for returning at least one characterization of at least of the relevant web pages for said at least one of the relevant publication items for which the respective publisher has authorized to display, providing an electronic path for accessing a copyrighted version thereof,
- wherein the means for returning at least one characterization of the relevant publication items includes returning information from an advertisement for said at least one of the relevant printed items."

With respect to Claim 43, an analogous art, Baxter, teaches:

- "with each stored data set representing printed items from publications, means for recording whether the respective publisher has authorized display of the printed item [Baxter, paragraphs [0037], [0041], [0141] and [0145]]
- for said at least one of the relevant publication items for which the respective publisher has authorized to display, [Baxter, paragraphs [0037], [0041], [0141] and [0145] with Thomson, col. 8, lines 4-10 with Thomson, col. 8, lines 47-57 with Thomson, col. 3, lines 50-65] providing an electronic path for accessing a copyrighted version thereof" [Baxter, paragraph [0144]].

With respect to Claim 43, an analogous art, Smith, teaches:

- "wherein the data sets representing printed items include advertisements related to the printed items, [Smith, cols. 2-3, lines 59-5] the advertisements including information for linking to information about a corresponding product; [Smith, cols. 2-3, lines 59-5 with Google1, page 1]

- wherein the means for returning at least one characterization of the relevant publication items includes returning information from an advertisement for said at least one of the relevant printed items" [Smith, cols. 2-3, lines 59-5 with Google1, page 1].

With respect to Claim 43, an analogous art, Google1, teaches:

- "means, responsive to a search query and including the search engine, for searching for web pages that are relevant for the search query [Google1, page 1]
- means for returning at least one characterization of at least of the relevant web pages" [Google1, page 1].

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Baxter, Smith, and Google1 with Thomson because the inventions are directed towards searching for documents.

Baxter, Smith, and Google1's inventions would have been expected to successfully work well with Thomson's invention because the inventions use databases. Thomson discloses an information management systems comprising searching for documents relevant to a query, however Thomson does not expressly disclose copyrighted material or that a publisher can authorize the display of items, web documents as search results and characterizations thereof, electronic reference for access, advertisements. Baxter discloses a method an apparatus for safeguarding files comprising copyrighted documents/publications and a way to determine if they should be displayed. Google1 discloses search results from Google comprising web pages as search results and characterizations thereof and an electronic reference for access.

Smith discloses system and methods for determining and displaying product promotions comprising a database of ads with their associated information.

It would have been obvious to one of ordinary skill in the art at the time of invention to take the copyrighted material with the determination if they should be displayed from Baxter, the database of ads with their associated information from Smith and the web pages as search results, characterizations thereof, and electronic paths for access from Google1 and install them into the invention of Thomson, thereby offering the obvious advantage of including more searchable material in the index of Thomson (as modified by Google1) to possibly retrieve more relevant results to a query, control the access to documents to safeguard them from non-authorized people, finding web pages associated with the documents found, accessing them and the user quickly determining the relevance of the returned result(s), showing most relevant results first and including a view to the original document, finding web pages associated with the documents found, accessing them and the user quickly determining the relevance of the returned result(s), and storing/maintaining the ads independently which allows for advertisements to be modified independently, and the reuse/repeating of the same advertisement multiple times.

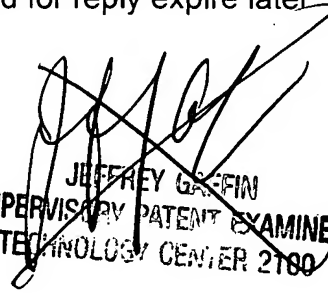
Thomson, Google1, Baxter, and Smith all fail to teach that advertisements are in printed items. Official notice is taken that it is old and well known in the document art that to get the advantage of complete document integrity it is necessary to include advertisements in the storing of printed items that contain advertisements. It would

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have been obvious to one of ordinary skill in the art at the time of invention to include advertisements to get this advantage.

36. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

  
JEFFREY GAFFIN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2160



### Conclusion

37. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is advised that, although not used in the rejections above, prior art cited on the PTO-892 form and not relied upon is considered materially relevant to the applicant's claimed invention and/or portions of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brent S. Stace whose telephone number is 571-272-8372 and fax number is 571-273-8372. The examiner can normally be reached on M-F 9am-5:30pm EST.

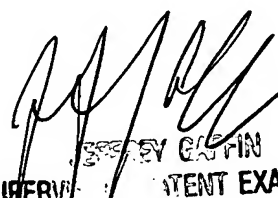
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Brent Stace

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